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| 10/603,933 | 06/26/2003 | Koichi Okada | Q75355 | 3426 |
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| EXAMINER | | | | |
| JONES, HEATHER RAE | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/603,933

Applicant(s)

OKADA ET AL.

Examiner

HEATHER R. JONES

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 26, 2007 have been fully considered but they are not persuasive.

The Applicant argues on page 2, line 13 – page 3, line 11 that the 101 rejection is improper. The Examiner respectfully disagrees and a further detailed explanation is given below.

The Applicant argues on page 4, line 1 – page 6, line 9 that the combination of Status Miller and Tsuchino can not be properly combined due to the images being recorded on different recording mediums. The Examiner respectfully disagrees. Status Miller and Tsuchino disclose developing x-ray images on film, which are both latent images. Since both develop latent images then it would benefit Status Miller as much as it does in Tsuchino to include the sensitivity of the recording medium. By informing the user of the sensitivity of the recording medium it allows the user to compensate for the sensitivity of the image while processing it in order to provide a higher quality image. Furthermore, by combining Tsuchino with Status Miller we are improving on the Status Miller reference. Therefore, the combination of Status Miller and Tsuchino is proper and the rejection is maintained.

The Applicant argues on page 7, lines 10-15 that Deguchi et al. fails to disclose or suggest recording the information on the package on the recording medium. The Examiner respectfully agrees. However, Deguchi et al. was only

referenced to disclose providing the attribute information of the image recording medium on the package. Tsuchino was referenced for disclosing the attribute information of the image recording medium on the image recording medium itself. Furthermore, Tsuchino discloses that the attribute information is first determined and later printed on the recording medium (col. 5, lines 24-34; col. 5, line 51 – col. 6, line 10). Therefore, it would have been obvious from combining Deguchi et al. with Status Miller and Tsuchino that the previously stored attribute information can come from reading the label placed on the package rather than testing for the unevenness of the recording medium. Therefore, the combination of Status Miller in view of Tsuchino in view of Deguchi et al. meets the claimed limitations and the rejection is maintained.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 defines an image recording medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to

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be realized" – Guidelines Annex IV). That is, the scope of the presently claimed image recording medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. Furthermore, this claim is broad enough to be read as an image signal being recorded on a computer readable program or a piece of paper.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Status Miller (U.S. Patent Application Publication 2001/0032101) in view of Tsuchino (U.S. Patent 5,260,573).

Regarding claim 1, Status Miller discloses a method of recording image data as a visible image on an image recording medium, comprising the steps of: recording at least attributes of the patient on the image recording medium in addition to an image recorded on the image recording medium. However, Status Miller fails to disclose recording at least attributes of the image recording medium itself on the image recording medium (Fig. 1, reference characters "711" and "712").

Referring to the Tsuchino reference, Tsuchino discloses a method of recording image data on an image recording medium, comprising the step of: recording information including at least attributes of the image recording medium on the image recording medium in addition to an image recorded on the image recording medium (Fig. 3, col. 5, lines 43-51; col. 5, line 58 – col. 6, line 10 – the recording medium's sensitivity is recorded onto the medium).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have recorded attribute information about the recording medium on the recording medium as taught by Tsuchino on the recording medium disclosed by Statius Miller in order to inform the user about any sensitivity unevenness the recording medium may have to allow a processor to compensate for it, therefore gaining a higher quality image.

Regarding claim **3**, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claim 1 including that the attributes are recorded in an area of the image recording medium other than the area thereof in which the image is recorded (Tsuchino: Fig. 3; Statius Miller: Fig. 1).

Regarding claim **4**, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claim 1 including that the attributes includes apparatus information of an apparatus for recording the image on the image recording medium (Tsuchino: col. 5, line 58 – col. 6, line 10 – the ID number representing the X-ray generator is written on the magnetic tape (21)).

Regarding claim **5**, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claim 1 including that the attributes are recorded as visible information on the image recording medium (Statius Miller: Fig. 1).

Regarding claim **6**, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claims 1 and 5 as well as disclosing that the method further comprises the steps of: converting the information into a predetermined display pattern; and recording the predetermined display pattern on the image recording medium (Statius Miller: Fig. 1 – bar code information).

Regarding claims **7-10**, this is a method claim corresponding to the apparatus claims 1, 3, 5, and 6. Therefore, the claim is analyzed and rejected as previously discussed with respect to claims 1, 3, 5, and 6.

Regarding claim **12**, this is a medium claim corresponding to the apparatus claim 1. Therefore, the claim is analyzed and rejected as previously discussed with respect to claim 1.

Regarding **13**, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claims 1 including that the image recorded on the image recording medium is viewable by an observer (Statius Miller: Fig. 1).

Regarding claim **14**, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claims 1, including that the

attributes of the recording medium comprises information corresponding to the image recording medium on which the attributes is recorded (Fig. 3, col. 5, lines 43-51; col. 5, line 58 – col. 6, line 10 – the recording medium's sensitivity is recorded onto the medium).

5. Claims 2, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchino in view of Statius Miller as applied to claims 1 and 7 above, and further in view of Deguchi et al. (U.S. Patent 6,133,984).

Regarding claim 2, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claim 1 including that the image data is recorded as the visible image on the image recording medium (Statius Miller: Fig. 1, reference characters "711" and "712"). However, Statius Miller in view of Tsuchino fail to disclose that the image recording medium is removed from a package of a plurality of image recording mediums, and wherein the attributes of the image recording medium comprises information indicated on at least the package.

Referring to the Deguchi et al. reference, Deguchi et al. discloses that the image recording medium is removed from a package of a plurality of image recording mediums, and wherein the attributes of the image recording medium comprises information indicated on at least the package (col. 5, lines 12-17 – the package contains information concerning the type of sensitivity and the size of the recording medium).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have removed the image recording medium from a package that contained a label on it describing the image recording medium as disclosed by Deguchi et al. and printing that information from the package onto the image recording medium like Statius Miller in view of Tsuchino prints the attribute information of the image recording medium onto the image recording medium in order to allow the user to correctly correspond the image recording medium with the package it was taken from in order to allow the user to recreate similar images using the same product again.

Regarding claim **11**, this is a method claim corresponding to the apparatus claim 2. Therefore, the claim is analyzed and rejected as previously discussed with respect to claim 2.

Regarding claim **15**, Statius Miller in view of Tsuchino discloses all the limitations as previously discussed with respect to claims 1 and 14, but fail to disclose that the attributes include at least one of terms of validity of the image recording medium; type of image recording medium; dates and times when packages of image recording medium were opened; temperature at which images recorded on the image recording medium were developed; production time; production place; production lot numbers and production company.

Referring to the Deguchi et al. reference, Deguchi et al. discloses that the attributes included on the recording medium include the type of recording medium (col. 5, lines 12-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have including the type of recording medium in the attribute listing as disclosed by Deguchi et al. with the attribute information disclosed by Statius Miller in view of Tsuchino in order to inform the user and the machine what kind of recording medium they are using and to allow for necessary changes to be made to accommodate for the recording medium.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER R. JONES whose telephone number is

(571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones
Examiner
Art Unit 2621

HRJ
March 17, 2008

/ROBERT CHEVALIER/
Primary Examiner, Art Unit 2621
March 17, 2008.